

## **REMARKS**

Applicants respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. No claims have been amended. Claims 15 and 17 have been canceled without prejudice. Claims 74 and 75 have been added. Thus, claims 1-14, 16, 18-22, 74 and 75 are pending.

### **35 U.S.C. §103(a) Rejections**

#### **35 U.S.C. §103(a) Rejection over *Hung***

The Office Action rejects claims 1, 3-19, 21 and 22 under §103(a) as being obvious in light of Hung, USPN 6,822,357 (hereinafter “*Hung*”). To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by one or more prior art references. See M.P.E.P. § 2143.03. The Office Action alleges that *Hung* discloses, *inter alia*, directing light outside a wheel such that an amount of light from the light source incident upon and reflected from a visible surface of the wheel is greater than an amount of light from the light source directed away from the visible surface of the wheel. Claims 15 and 17 are canceled herein, rendering moot the above rejection as applied thereto. For at least the following reasons, Applicants traverse the above rejection as applied to the remaining claims 1, 3-14, 16, 18, 19, 21 and 22.

Applicants respectfully submit that each of the above rejected claims is not obvious in light of *Hung*, based at least on the failure of *Hung* to teach or suggest (emphasis added):

“...the positioning means to allow light from the light source directed outside the wheel such that an amount of light from the light source **incident upon and reflected** from a **visible surface** of the wheel is greater than an amount of light from the light source **directed away** from the **visible surface** of the wheel.”

as variously recited in current independent claim 1. Applicants note that independent claim 1 recites limitations related to the directing of light with respect to a **visible surface** of a wheel. A **visible surface** of the wheel is to be distinguished both from any part of

the wheel which is either **not a surface** of the wheel or a surface of the wheel which is, for example, obstructed, covered or otherwise **hidden from view**.

In rejecting the above claims, the Office Action relies on *Hung*, FIG. 5 as anticipating the above cited limitations. More particularly, page 2, last line to page 3, line 4 of the Office Action states in a salient portion (emphasis added):

“As shown in Figure 5, the positioning of the light source is such that there is no unobstructed light emitted directly away **from a surface of the wheel**. The entire light source is position such that all emitted light is channeled through the conductor which immediately refracts and reflect the light **onto the wheel surface** and outward.”

Here, the Office Action describes *Hung* as allegedly reflecting light “from a surface” of wheel (5), while overlooking the fact that claim 1 is **more particularly** directed to light which is incident upon and reflected from a **visible surface** of a wheel. The Office Action makes no attempt to address Applicants claimed invention vis-à-vis the directing of light with respect to a **visible surface** of a wheel. Consequently, the interpretation of the claims in the Office Action essentially **removes** one of the limitations of claim 1. As stated in M.P.E.P. §2111, during patent examination, the pending claims must be given their broadest **reasonable** interpretation consistent with the specification. M.P.E.P. §2111 *citing* the Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Applicants respectfully submit that any interpretation of claim 1 which **removes** one of the limitations of claim 1 is an **unreasonable** interpretation.

For the purposes of providing a full response to the Office Action, Applicants describe below how *Hung* **fails** to disclose an amount of light from a light source incident upon and reflected from a **visible surface** of a wheel which is greater than an amount of light from the light source directed away from the **visible surface** of the wheel. FIG. 5 of *Hung* shows a groove (50a) disposed on a wheel spoke (50) of the wheel (5) for **inserting** and securing the light conductor (3) therein. *See, e.g. Hung* col. 3, lines 15-18. However, conductor (3) is **inserted in groove (50a)** such that any light from conductor (3) would **either** be directed **away** from wheel (5) **or** be incident upon **only** those parts of wheel (5) which form the groove (50a) into which conductor (3) is inserted. Applicants note that

any light from conductor (3) which is directed **away** from wheel (5) is *per se* directed away from both any visible surface of the wheel (5) and any other surface or element of the wheel (5). Applicants further note that any remaining light emitted from conductor (3) – i.e. the light which is incident upon those parts of wheel (5) which form the groove (50a) – is either light which is not incident upon a **surface** of the wheel or light which is not incident upon a **visible surface** of the wheel, as discussed below.

FIG. 5 of *Hung* shows that by being inserted in groove (50a), conductor (3) obstructs, covers, or otherwise hides those parts of wheel (5) which form the groove (50a). In other words, by virtue of the positioning of conductor (3), groove (50a) is simply **not visible**, and any given part of wheel (5) which forms groove (50a) is **not a surface** of wheel (5), insofar as it is covered by (i.e. underneath) conductor (3). Assuming *arguendo* that a given part of wheel (5) which forms groove (50a) **were** considered a surface, which Applicants do not agree, any such surface would nevertheless not be a **visible surface**, insofar as the positioning of conductor (3) in groove (50a) **prevents** that part of wheel (5) from being viewed. *Hung fails* to disclose any part of wheel (5) which forms groove (50a) as being in any way visible through conductor (3). By way of illustration, *Hung* fails to describe any translucency, transparency, etc. of conductor (3). Nor does *Hung* provide for any **other** way in which groove (50a) may be visible. Therefore, any light from conductor (3) which may be incident on parts of wheel (5) which form groove (50a) is not light which is **incident upon a visible surface** of the wheel (5), as recited in Applicants' claim 1.

Further assuming *arguendo* that some small part of groove (50a) was part of the **visible** surface of wheel (5), which Applicants do not agree, any amount of light which would be **incident upon** and **reflected from** such a small part of groove (50a) would be **very minimal**, compared to the **large amount** of light from conductor (3) which is directed away from wheel (5). Since *Hung fails* to disclose an amount of light which is incident upon a **visible surface** of wheel (5), any amount of light from conductor (3) which is **directed away** from wheel (5) is necessarily **greater than** any amount of light from conductor (3) which is **incident upon** and reflected from a **visible surface** of wheel

(5). Hence, *Hung* necessarily **fails** to disclose an amount of light **incident upon** and reflected from a **visible surface** of a wheel which is **greater than** an amount of light from the light source **directed away** from the **visible surface** of the wheel. Therefore, the cited references fail to either teach or suggest at least one limitation of the invention as recited in independent claims 1.

Accordingly, independent claim 1 is non-obvious in light of *Hung*. If an independent claim is non-obvious under 35 U.S.C. §103, then any claims depending therefrom – e.g. claims 3-19, 21 and 22 – are also non-obvious. *See* M.P.E.P. §2143.03. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of pending claims 1, 3-14, 16, 18, 19, 21 and 22 based on *Hung* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Hung* and *Ellis***

The Office Action rejects claim 2 under §103(a) as being obvious in light of *Hung* in view of *Ellis*, USPN 6,059,431 (hereinafter “*Ellis*”). In rejecting claim 2, the Office Action relies at least in part on the above-discussed 35 U.S.C. §103 rejection of independent claim 1 based on *Hung* alone. The Office Action further alleges that *Ellis* discloses, *inter alia*, a filament type based lamp. Applicants traverse the above rejection for at least the following reasons.

Claim 2 depends directly from independent claim 1. As discussed above, *Hung* fails to teach or suggest at least one limitation of claim 1, e.g. an amount of light **incident upon** and reflected from a **visible surface** of a wheel which is **greater than** an amount of light from the light source **directed away** from the **visible surface** of the wheel. In rejecting claim 2, the Office Action fails to allege that *Ellis* teaches or suggests those limitations of claim 1 which are not taught or suggested by *Hung* alone.

Applicants submit that no combination of *Hung* and *Ellis* teaches or suggests an amount of light **incident upon** and reflected from a **visible surface** of a wheel which is **greater than** an amount of light from the light source **directed away** from the **visible surface** of the wheel, as recited in claim 1. Accordingly, independent claim 1 is non-obvious in light of *Hung* and *Ellis*. If an independent claim is non-obvious under 35 U.S.C. §103, then any claims depending therefrom – e.g. claim 2 – are also non-obvious.

See M.P.E.P. §2143.03. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of claim 2 based on *Hung* and *Ellis* be withdrawn.

### **New Claims**

Applicant has added new claims, 74 and 75, which variously depend from claim 1. New claims 74 and 75 are supported in the original disclosure at least by paragraphs [0055] and [0058] of the specification. It is Applicant's understanding that new claims 74 and 75 are allowable at least insofar as the new claims incorporate limitations of independent claim 1 which are neither taught nor suggested by any combination of *Hung* and *Ellis*. Furthermore, neither *Hung* nor *Ellis* teach or suggest modifying a wheel surface to change an angle of reflection of light from the light source such that light from the light source which would not be visible in a given observation region but for the modification of the surface of the wheel is visible in the given observation region. More particularly, neither *Hung* nor *Ellis* discloses modifying the surface of a wheel by at least one of machining, bead blasting, chemical etching, applying a chemical coating, applying a decal and plating.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-14, 16, 19-22 and 74-75 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

Date: November 13, 2007

/Dermot G. Miller/

Dermot G. Miller  
Attorney for Applicant  
Reg. No. 58,309

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(503) 439-8778